

JAN 28 1980

MICHAEL BODAK, JR., CLERK

IN THE
Supreme Court of the United States

No. 79-839

IRONS AND SEARS,

Petitioner

v.

COMMISSIONER OF PATENTS AND TRADEMARKS,
Respondent

**REPLY MEMORANDUM IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA CIRCUIT**

EDWARD S. IRONS

1785 Massachusetts Avenue, N.W.

Washington, D.C. 20036

(202) 466-5200

Attorney for Petitioner

IN THE
Supreme Court of the United States

No. 79-839

IRONS AND SEARS,
Petitioner

v.

COMMISSIONER OF PATENTS AND TRADEMARKS,
Respondent

**REPLY MEMORANDUM IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA CIRCUIT**

1. Absent the review sought here, the Patent Office will persist unfettered in its pattern of egregious disregard for the Freedom of Information Act's broad disclosure mandate. The problem is now acute and of vital importance to the administration of both the patent laws and the FOIA. Its resolution by this Court is long overdue.

2. Contrary to the respondent's representation to this Court, 35 U.S.C. § 122 does *not* "specifically" provide that "information concerning patent applications *must* be kept confidential" or that "no information" concerning patent applications may be released" (Opp. 3).

This seemingly calculated distortion of what the statute *really* says¹ is just a misguided effort to blunt the force of petitioner's Questions 2 and 3, namely

2. Is 35 U.S.C. § 122 a statute which "refers to particular types of matters to be withheld" within the meaning of exemption 3 (5 U.S.C. § 552(b) (3)) of the Freedom of Information Act (FOIA)?

3. Does the segregability clause of the FOIA, 5 U.S.C. § 552(b), apply to "applications for patents" or to "information concerning the same" contemplated by 35 U.S.C. § 122?

3. The conflict in decision between *Irons v. Gottschalk*, 548 F.2d 992, 996-7 (D.C. Cir. 1976), that:

§ 122 . . . exempts *only* portions of the requested material *containing detailed information and salient knowledge* pertaining to patent applications

and the ruling in this case that, in enacting § 122

Congress seems to have intended to draw a bright line shielding from disclosure *all* information concerning patent applications . . . a flat prohibition on disclosure . . . (Pet. App. 11a)

is both manifest on the face of the opinions and acknowledged by the panel which rendered the decision below. See P.Br. 11; Pet. App. 10a, n. 30.

(a) Respondent's representation that *Irons* "is inapposite" because that panel's reference to "non-exempt" material adverts only to "information concerning existing patents" is disingenuous (Opp. 3). The *Irons* opinion

¹ 35 U.S.C. § 122 provides:

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

neither makes nor implies any such limitation on the ruling there—but instead holds that "non-exempt" material includes everything which is *not* "detailed information and salient knowledge" pertaining to the invention.

(b) *Wisniewski v. United States*, 353 U.S. 901 (1957) (Opp. 4, n. 3) is not concerned with granting of a "writ of certiorari", but only with a question certified by the court of appeals. Its pertinent passage states "desirable judicial administration commends consistency at least in the more or less contemporaneous decisions of different panels of a Court of Appeals. . . . It is primarily the task of the Court of Appeals to reconcile its internal difficulties . . .". *Ibid* at 902.

In this case, the court of appeals has refused to reconcile its internal difficulties but instead has summarily "denied" a timely Petition for Rehearing *en banc* seeking such reconciliation.

4. As the Petition notes, p. 11, n. 10, the decision in *this case also conflicts* with the decision of the Ninth Circuit in *Lee Pharmaceuticals v. Kreps*, 577 F.2d 610 (1978), with respect to the interpretation of the confidentiality proviso of § 122.

In *accord* with *Irons*, but in *conflict* with the decision below, the Ninth Circuit held that the "purpose of the confidentiality proviso" of § 122 is to prevent "inventor's discoveries" from becoming "public knowledge before a patent is secured". 577 F.2d at 616. The respondent does not contend that such information is present in, or, if present, could not be deleted from, the administrative decisions sought by petitioner.

² The *Lee Pharmaceuticals* and *Irons* decisions elucidate the "particular governmental purpose" (P.Br. 15; cf. Opp. 2) of the confidentiality requirement of § 122—which the decision below ignores.

5. The *Lee Pharmaceuticals* and *Irons* cases, "confronted with two statutes 'capable of coexistence,'" discharged their "duty . . . to regard each as effective". *Administrator, FAA v. Robertson*, 422 U.S. 255, 266 (1975).

The panel in this case, derogating *Robertson*, abjured that "duty" and eviscerated exemption 3 of the FOIA. See P.Br. 15.

EDWARD S. IRONS
1785 Massachusetts Avenue, N.W.
Washington, D.C. 20036
(202) 466-5200

Attorney for Petitioner